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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/638,211	08/08/2003	Benjamin A. Pullen	2003-0483.01	5544
21972	7590	03/04/2009	EXAMINER	
LEXMARK INTERNATIONAL, INC. INTELLECTUAL PROPERTY LAW DEPARTMENT 740 WEST NEW CIRCLE ROAD BLDG. 082-1 LEXINGTON, KY 40550-0999			HASSAN, AURANGZEB	
		ART UNIT	PAPER NUMBER	
		2182		
		MAIL DATE		DELIVERY MODE
		03/04/2009		PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/638,211	Applicant(s) PULLEN ET AL.
	Examiner AURANGZEB HASSAN	Art Unit 2182

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 01 December 2008.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1,3-11 and 32-37 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1,3-11 and 32-37 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/1449)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____

5) Notice of Informal Patent Application
 6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1, 10, 32 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Furukawa et al. (US Publication Number 2001/0039590 hereinafter “Furukawa”) in view of *HKU Campus Network Handbook Chapter 4 – Network Printing (HKU Campus Network Handbook - Last Update 7/16/1998, Chapter 4 –Network Printing*, hereinafter “HKU”).**

3. As per claim 1, Furukawa teaches a method of configuring a peripheral device on a network, the method comprising the acts of:

sending a request from a host to the peripheral device across the network (paragraphs [0019 & 0033]);

receiving a response from the peripheral device, the response including a current configuration setting of the peripheral device (paragraph [0019 & 34]); and

determining whether to configure the peripheral device, without user intervention (host computer determines whether to configure, paragraph [0034]); and

sending a configuration message to the peripheral device, the configuration message including an updated configuration setting for the peripheral device, the configuration message including a network parameter associated with a network connection of the peripheral device (settings include IP address configuration, paragraphs [0033-0034]), the updated configuration setting generated and sent by the host without user intervention (host sends to the printer via multicast, paragraph [0034]).

Furukawa does not explicitly disclose the configuration message including functional settings.

Transmission of functional settings to a printer is notoriously well known in the art as they are essential for functionality and are incorporated into print jobs. Furthermore HKU teaches configuring and sending a print job comprising a configuration message including a functional parameter associated with a device-specific operation of the peripheral (Chapter 4, Section 4.3, Step 15, Printer Settings).

Sending functional parameters in a configuration message is notoriously well known in the art as can be clearly seen in HKU with examples shown from Windows 3.1 and it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify Furukawa by including a configuration message including functional parameters as reinforced by HKU. One of ordinary skill would be motivated to make such modifications in order to allow for functionality in a network environment (Chapter 4, Section 4.1).

4. As per claim 10, Furukawa teaches a method wherein a configuration utility software is installed on the host (the program embodied in figure 5 is installed on the host).

5. As per claim 32, Furukawa teaches a method wherein the request is a query packet (query packet, paragraph 0019) and the host includes a configuration utility (configuration utility in host as embodied in figure 5), and further comprising the acts of: receiving the query packet by the peripheral device over the network (figure 4a) from a the configuration utility (paragraph 0019); sending the response to the configuration utility in response to the query packet, the response including the current configuration setting of the peripheral device (figure 4a, printer returns current MAC address) and indicating that the peripheral device recognizes the query packet (paragraph 0019); receiving a configuration packet by the peripheral device over the network from the configuration utility (paragraph 0033-0034); parsing the configuration packet for an updated configuration setting (paragraph 0034); and changing the current configuration setting of the peripheral device to match the updated configuration setting included in the configuration packet (paragraph 0034, printer sets the new configuration information).

6. As per claim 36, Furukawa teaches a method wherein an acknowledgment packet is sent to the configuring utility after the new configuration has been accepted (ACK packet, S9, figure 5, paragraph 0037).

7. **Claims 3, 7 – 9, 11, 33 – 35 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Furukawa in view of Ohta (US Publication Number 2003/0084132).**

8. As per claim 3, Furukawa teaches a configuration message however does not disclose data payload.

Ohta teaches a method wherein the configuration message includes a data payload (.dll data payload files, paragraph [0036]).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the configuration message of Furukawa to include the additional data of Ohta. One of ordinary skill would be motivate to make such modification in order to increase the availability of parameters to be modified (paragraph [0005]).

9. As per claims, 7, 8, 9 and 37, Furukawa teaches a method wherein the peripheral device is selected from the group of network devices such as a printer (paragraph 0007, figure 4) and Ohta teaches a method wherein the peripheral device is selected from the group consisting of: a print server, a network adaptor, a scanner, a printer, an all-in-one-device, and a fax machine (peripheral device includes a multitude of devices, paragraph [0052]).

All of the component parts of Furukawa and Ohta were known at the time of the Applicant's claimed invention the only difference is the combination of the known elements in a single networked peripheral selectable system thus it would have been obvious to one of ordinary skill in the art to combine all the elements into a single system to yield a predictable result of selecting a peripheral to configure.

10. Furukawa (note claim 1) modified by the teachings of Ohta as applied in claim 3 above, as per claim 11, Ohta teaches a method wherein the configuration setting includes one of: a network setting (figure 12) and a device-specific setting (figure 15).

11. Furukawa modified by the teachings of Ohta as applied in claim 3 above, as per claims 33, 34, 35, Ohta teaches a method wherein the configuration settings are communicated by binary data wherein the binary data is a series of delimited text strings and is encrypted data (.dll data payload files, paragraph [0036]).

12. Claims 4, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Furukawa in view of HKU further in view of Cheng (US Publication Number 2002/0078161).

13. As per claims 4, 5 and 6, Furukawa teaches a method of configuring a peripheral device on a network, the method comprising the acts of: sending a request from a host

across the network via broadcast (broadcast taught as known in prior art, paragraph [0007]) and multicast (paragraph [0019])

Furukawa does not explicitly disclose the streaming mechanism unicast.

Cheng teaches the streaming mechanisms utilized in sending requests via unicast (paragraph [0024]).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the combination of HKU and Furukawa with the above teachings of Cheng. One of ordinary skill in the art would be motivated to make such modifications in order to allow for a more variety in a heterogeneous network in an a home and office environment (paragraphs [0007 & 0024]).

Response to Arguments

14. Applicant's arguments filed 12/01/2008 have been fully considered but they are not persuasive. The applicant argues 1) that the determination of whether to configure a peripheral device of Furukawa is not done without user intervention. 2) HKU teaches a standalone PC and not a peripheral device and 3) one would not be motivated to combine Furukawa and HKU.

15. As per argument 1, the Examiner respectfully disagrees. The applicant argues that the determination step is not done without user invention and has cited figure 5 with respect to the claimed invention however the user invention in Furukawa is directed to the receiving a response from the peripheral device as claimed and not the

determination step. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., sending a request and receiving a response steps are done without user invention) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

16. As per argument 2, the Examiner respectfully disagrees. The applicant argues that HKU teaches a standalone PC and not a peripheral device. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The Examiner relies upon Furukawa for teachings of a peripheral and relies upon HKU for teachings of configuration messages including functional settings.

17. As per argument 3, the Examiner respectfully disagrees. The applicant argues motivation to combine Furukawa with HKU however Furukawa is directly related to configuration of a peripheral device and HKU is merely relied upon for teachings that a configuration message can be comprised with functional settings. HKU teaches a peripheral that is connected to the network (network printer) and receives configuration settings from a node on the network. Clearly one of ordinary skill in the art would

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recognize that settings in one peripheral and network environment of Furukawa can adapt settings from another networked peripheral of HKU.

Conclusion

18. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AURANGZEB HASSAN whose telephone number is (571)272-8625. The examiner can normally be reached on Monday - Friday 9 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571)272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AH

/Ilwoo Park/
Primary Examiner, Art Unit 2182
March 2, 2009